

REMARKS

Status of the Claims

Claims 1-41 are pending in this application.

Claims 1-21, 23-25 and 27-41 are currently under examination and stand rejected.

Although no claim amendments are made in this paper, a complete listing of the pending claims is provided for the Examiner's convenience.

Claim Rejections

35 U.S.C. §103(a)

Independent claims 1 and 27 are currently under examination with respect to the elected species of skin condition "enlarged pores." These claims stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Beerse et al. (U.S. Patent No. 6,294,186), in view of Duennenberger et al. (U.S. Patent No. 3,708,527), Perricone (U.S. Patent No. 6,743,433), and Wiegand et al. (U.S. Patent Pub. 2002/0151527). Applicants traverse this rejection.

Briefly, the Examiner contends that it would have been obvious to use halo-salicylic acid to treat enlarged pores associated with acne because (i) "the halogenated salicylic acid" of Beerse et al. "is known to be useful for treatment of acne," and (ii) Perricone allegedly "reveals that acne is associated with skin pore size and treatment of acne is also beneficial in reducing pore size." Moreover, the Examiner contends that it also "would have been obvious to apply the composition to skin . . . without acne because the compound is known to prevent (suppress) the development of acne" and thus one skilled in the art "would have been motivated to apply the compound to skin area with enlarged pore size (previously infected with acne) for preventing a relapse." (OA, ¶ 5) (emphasis added). Regardless of the correctness of the Examiner's contention that one skilled in the art would have been motivated to use halo-salicylic acid for the prevention of acne on skin that is not affected by acne, the rejection is deficient because the Examiner has provided no evidence that skin which "is not affected by acne" necessarily suffers from "enlarged pores."

Absent the presence of enlarged pores in skin which “is not affected by acne,” it is not seen how applying halosalicylic acid to such skin will invariably practice the claimed method of “reducing the size of enlarged skin pores.” To defeat patentability of Applicants’ claimed method, it is not sufficient to speculate that some individuals in need of acne prevention may have enlarged pores. See MPEP § 2112 (“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.”); In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”). Rather, it must be shown that the practice of the prior art necessarily practices the claimed method. See MPEP § 2112; Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”).

The Examiner does not offer any evidence to support the contention that skin “previously infected by acne,” but which is not currently affected by acne, necessarily is characterized by enlarged pores, and, indeed, none of the art of record supports such a conclusion. The Perricone reference relied on by the Examiner states that the “active phase” of acne is characterized by “inflammatory and noninflammatory lesions (including pustules, papules and comedones)” and that “atrophic scars” remain after resolution of the active phase. [col. 1, lines 18-23]. To contend that atrophic acneform scars would be considered “enlarged pores,” would be unreasonable, as inconsistent with science and the understanding of one skilled in the art. See In re Buszard, 504 F.3d 1364 (Fed. Cir. 2007); In re Cortright, 165 F.3d 1353, 1358 (Fed. Cir. 1999) (“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.”)

Because none of the art of record teaches or suggests applying the claimed halosalicylic acid compounds to skin suffering from enlarged pores, in the absence of acne, the presently claimed methods cannot be anticipated or rendered obvious. See Perricone v. Medicis Pharm. Corp., 432 F.3d 1368 (Fed. Cir. 2005) (“The issue is not . . . whether Pereira’s [prior art] lotion if applied to skin sunburn would inherently treat that damage, but whether Pereira discloses the

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application of its composition to skin sunburn. It does not.”). Accordingly, Applicants respectfully submit that the rejection is improper and should be withdrawn.

Having distinguished the independent claims, Applicants submit that the claims dependent therefrom are patentable for at least the same reasons. However, Applicants reserve the right to separately address the patentability of the dependent claims in the future, should that be necessary.

CONCLUSION

Applicants respectfully submit that the instant application is in condition for allowance. Entry of the amendments and an action passing this case to issue is therefore respectfully requested. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

Respectfully submitted,

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